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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,220	07/12/2001	Jurgen Dannenmaier	GAMBRO-254	8402
530	7590	04/16/2004	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			MENON, KRISHNAN S	
			ART UNIT	PAPER NUMBER
			1723	

DATE MAILED: 04/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/889,220

Applicant(s)

DANNENMAIER ET AL.

Examiner

Krishnan S Menon

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 03 October 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 13-25.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: response to arguments

Response to Arguments

Applicant's arguments filed 10/3/03 have been fully considered but they are not persuasive.

Re the applicant argument that Oscarsson teaches a hollow fiber fluid fractionation cell, this is a hollow fiber membrane filter for dialysis as explained in the abstract of Oscarsson; applicant discloses a filter for dialysis in the introductory paragraph on page 1 of the specification.

Re the argument that "identical invention must be shown .. in as much complete detail...", referring to Oscarsson's teaching of the prior art method and Oscarsson's improvement over it. Applicant also argues that it is improper to pick one or more steps from Baudet's method and substitute for Oscarsson's method. However, it may be noted that first of all, claim 13 does not recite potting the ends of the fibers; secondly, the so called 'replaced steps' are what the ref teaches as improvements.

Majority of the applicant's arguments dwell on matters not recited in the claims.

Applicant's main arguments are in regard to independent claim 13, particularly, in regard to when the potting of the ends of the fiber is done in the claim. Applicant argues in page 4 of the argument in the underlined text, "simultaneously adhering together the first and the second housing portion by means of a potting compound when the hollow fiber ends are potted", as being recited by claim 13. However, the claim does not recite potting the ends of the fibers. The claim only recites 'connecting said plurality of hollow fibers together at least one of said first and second ends of said filter housing', which does not mean potting. The Oscarsson reference teaches an improvement over the

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step of 'potting the fibers within the cell section before taking them off the winding device', which step, even if a less desired, is still anticipatory. A reference is no less anticipatory if, after disclosing the invention, the reference then disparages it. The question whether a reference "teaches away" from the invention is inapplicable to an anticipation analysis. *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998).

Applicant argues that in the present invention, adhering together the housing portions before the fiber ends are potted ... - again, matter not claimed in the claims.

Arguments re claim 22: this is a product claim, and when the potting is done is immaterial to the product. Argument that the housing portions are sealed by the potting compound: so is in Oscarsson – the housing portions are at least partially (at the ends where the hollow fiber ends are sealed) sealed by the potting compound; the claim is open-ended.

Re the argument that there is no motivation to use a heat or mass transfer apparatus as in the Baurmeister ref in the 103 rejection – does the applicant imply that the reference is non-analogous to the applicant's invention? One of ordinary skill in the art of dialysis would know that dialysis is a mass-transfer process. More over, the reference teaches that they are used as dialyzers in the abstract. Re the argument that the ref uses a number of film hinges whereas applicant uses only one, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the

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test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Rest of the arguments are already addressed in the final rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Krishnan Menon
Patent Examiner


W. L. WALKER
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